

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s):	Akira KURIYAMA, et al.	Confirmation No.:	1255
Serial No.:	10/735,062	Examiner:	Evan T. PERT
Filed:	December 11, 2003	Group Art Unit:	2826
For:	A METHOD OF MANUFACTURING A SEMICONDUCTOR DEVICE		
Customer ID:	27123		

**PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT**

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for reconsideration of the November 7, 2006  
Determination of Patent Term Adjustment under 35 U.S.C. §154(b) indicating a Patent Term  
Adjustment of 411 days for the above-referenced application. According to 37 C.F.R. §1.705(b),  
applicants submit herewith:

- 1) the fee set forth in 37 C.F.R. §1.18(e), and
- 2) a statement of the facts involved.

**STATEMENT OF FACTS**

The present application was filed in the U.S. Patent and Trademark Office (USPTO) on December 11, 2003 and thereby enabling eligibility of the instant application for Patent Term Adjustment under 35 U.S.C. §154.

The Examiner mailed a Non-Final Rejection on November 4, 2005, which is 266 days beyond the initial fourteen (14) months response period.

Applicants responded by filing an Amendment on February 6, 2006. The Amendment was received by the USPTO on the same day (February 6, 2006), which is 2 days beyond the three (3) months response period. Subsequently, Applicants submitted an Information Disclosure Statement (IDS) along with a PTO-1449 form listing the cited references and copies of the non-U.S. and non-patent references on February 7, 2006. As illustrated below, the IDS was received by the USPTO on **February 7, 2006**. However, the Patent Term Adjustments calculations as provided by the PAIR system (Exhibit A) erroneously relied on a February 13, 2006 date for the filing and receipt of this IDS submission.

Attached herewith is a copy of the IDS as it appears in the PAIR system (Exhibit B). The IDS was filed by Applicants' representative on February 7, 2006 and stamped by the Office of Initial Patent Examination (OIPE) with a date of February 7, 2006, indicating receipt by the USPTO on the same day.

Applicants also provide herewith a copy of the self-addressed stamped post-card received from the USPTO in connection with filing of the IDS (Exhibit C). The postcard receipt was also stamped by the OIPE with a date of February 7, 2006 and indicates that the IDS was received by the USPTO on that day. According to MPEP §503, such a postcard receipt may

serve as *prima facie* evidence of receipt in the USPTO of the items listed thereon on the date stamped thereon by the USPTO.

Applicants respectfully request reconsideration of the Patent Term Adjustment, specifically for reduction of period of adjustment of patent term. Applicants understand that submission of a supplemental reply or other paper after a reply has been filed would reduce the period of adjust of patent term by the number of days, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed. However, Applicants respectfully submit that the date for the IDS as identified in the PAIR system and relied on by the Patent Term Determination calculations was erroneous. The period of reduction for the subsequent submission of the IDS should have been for 1 day, which begins on the day after the reply was filed (i.e., February 7, 2006) and the date the IDS was filed (i.e., February 7, 2006), and not 7 days.

The Examiner mailed a Notice of Allowance on November 7, 2006, which is 154 days beyond the four (4) months response period.

Applicants believe that the period of adjustment of patent term due to examination delay should be 420 days reduced by a total of 3 days, 2 days for filing a response to a non-final office beyond the three months response period and 1 day for the subsequent submission of the IDS. Applicants believe that the number of days extending the patent term should be 417 days.

The present application is not currently subject to a terminal disclaimer.

**CONCLUSION**

In considering the evidence as supported by the attached Exhibit demonstrating the filing and receipt by the USPTO of the IDS as **February 7, 2006**, Applicants respectfully request reconsideration of the Patent Term Adjustment and request that the instant application be accorded a **Patent Term Adjustment of 417 days**.

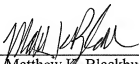
**AUTHORIZATION**

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 1232-5237. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: November 29, 2006

By: \_\_\_\_\_

  
Matthew K. Blackburn  
Registration No. 47,428

**Correspondence Address:**

MORGAN & FINNEGAN, L.L.P.  
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(212) 415-8701 Facsimile

# Exhibit A

Search results as of: 11-29-2006::15:05:04 E.T.

**Patent Term Adjustment**

Filing or 371(c) Date:	12-11-2003	USPTO Delay (PTO) Delay (days):	420
Issue Date of Patent:	-	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	9
Post-Issue Petitions (days):	+0	Total Patent Term Adjustment (days):	411
USPTO Adjustment(days):	+0	Explanation Of Calculations	

**Patent Term Adjustment History**

Date	Contents Description	PTO(Days)	APPL(Days)
11-07-2006	Mail Notice of Allowance	154	
11-03-2006	Document Verification	⬆	
11-03-2006	Notice of Allowance Data Verification Completed	⬆	
11-03-2006	Case Docketed to Examiner in GAU	⬆	
02-07-2006	Reference capture on IDS	⬆	
02-13-2006	Information Disclosure Statement considered	⬆	
02-13-2006	Information Disclosure Statement (IDS) Filed		7
02-10-2006	Date Forwarded to Examiner		⬆
02-06-2006	Response after Non-Final Action		2
11-04-2005	Mail Non-Final Rejection	266	
10-31-2005	Non-Final Rejection	⬆	
04-26-2005	Miscellaneous Incoming Letter	⬆	
01-25-2005	Case Docketed to Examiner in GAU	⬆	
01-18-2005	Case Docketed to Examiner in GAU	⬆	
01-04-2005	Case Docketed to Examiner in GAU	⬆	
11-09-2004	Case Docketed to Examiner in GAU	⬆	
08-09-2004	Correspondence Address Change	⬆	
05-12-2004	IFW TSS Processing by Tech Center Complete	⬆	
05-12-2004	Case Docketed to Examiner in GAU	⬆	
04-26-2004	Request for Foreign Priority (Priority Papers May Be Included)	⬆	
05-06-2004	Application Return from OIPE	⬆	
05-06-2004	Application Is Now Complete	⬆	
05-06-2004	Application Return TO OIPE	⬆	
05-06-2004	Application Return from OIPE	⬆	
05-06-2004	Application Return TO OIPE	⬆	
05-06-2004	Application Dispatched from OIPE	⬆	
05-06-2004	Application Is Now Complete	⬆	
04-23-2004	Additional Application Filing Fees	⬆	
04-23-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applicant	⬆	
03-22-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	⬆	
02-27-2004	Cleared by L&R (LARS)	⬆	

02-17-2004	Referred to Level 2 (LARS) by OIPE CSR	⌵
01-09-2004	IFW Scan & PACR Auto Security Review	⌵
12-11-2003	Initial Exam Team nn	⌵

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**Close Window**

# **Exhibit B**



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): A. KURIYAMA, et al.

Group Art Unit: 2812

Serial No.: 10/735,062

Examiner: E. PERT

Filed: December 11, 2003

For: SEMICONDUCTOR DEVICE AND METHOD OF MANUFACTURING THE SAME

INFORMATION DISCLOSURE STATEMENT

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to Rule 56, applicant hereby calls the attention of the Patent Office to the references listed on the attached Form PTO 1449.

Copy(ies) of these references:

- ☒ Foreign Patent Applications, Foreign Patents and/or Other Non-Patent Documents are attached (Copies of cited U.S. Patents/Publications are not provided).
- ☐ Were filed in related application U.S. Serial No(s) \_\_\_\_\_, filed \_\_\_\_\_, respectively.
- ☐ This document is being filed within three (3) months of the filing date of the application
- ☒ Charge the requisite fee of \$180.00 to Deposit Account No. 13-4500, Order No. 1232-5237.
- ☐ This document is being concurrently filed with the above-identified application
- ☐ This document is being concurrently filed with an Request for Continued Examination (RCE)
- ☐ This document is being filed prior to a first Office Action
- ☐ This document is being accompanied by a Search Report/Communication cited in a corresponding PCT or foreign counterpart application.
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required for this Information Disclosure Statement, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1232-5237. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: February 7, 2006By: 

Eric G. Wright  
Registration No. 48,045

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FORM PTO-1449A

## INFORMATION DISCLOSURE CITATION

Attorney Docket:  
1232-5237Serial No.:  
10/735,062Applicant:  
A. KURIYAMA, et al.Filing Date:  
December 11, 2003Group Art Unit:  
2812

## U.S. PATENT / PUBLICATION DOCUMENTS

Examiner Initial	Patent/Publication Number	Publication/Issue Date	Name	Filing Date
	1. US 2005-0053773 A1	03-10-2005	Fukutani	
	2. US 2004-0043208 A1	03-04-2004	Fukutani	
	3. US 2004-0048092 A1	03-11-2004	Yasui	
	4. US 2004-0033339 A1	02-19-2004	Fukutani	
	5. 6,602,620	08-05-2003	Kikitsu	
	6. 6,027,796	02-22-2000	Kondoh	
	7.			
	8.			
	9.			
	10.			
	11.			

## FOREIGN PATENT DOCUMENTS

Examiner Initial	Patent Number	Publication Date	Country	Copy Filed	Translation
	12. 2001-261376 A	09-26-2001	Japan	<input checked="" type="checkbox"/> Yes	Abstract o
	13. 2001-162600	06-19-2001	Japan	<input checked="" type="checkbox"/> Yes	Abstract
	14. 10-321834	12-04-1998	Japan	<input checked="" type="checkbox"/> Yes	Abstract
	15. H09-157062 A	06-17-1997	Japan	<input checked="" type="checkbox"/> Yes	Abstract
	16. WO 03/078688	09-25-2003	WIPO	<input checked="" type="checkbox"/> Yes	Abstract
	17. WO 03/078687	09-25-2003	WIPO	<input checked="" type="checkbox"/> Yes	Abstract
	18. WO 03/078685	09-25-2003	WIPO	<input checked="" type="checkbox"/> Yes	Abstract
	19. WO 03/069677	08-21-2003	WIPO	<input checked="" type="checkbox"/> Yes	N/A

Examiner

Date Considered

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP §609.  
 Draw line through citation if not in conformance and not considered.  
 Include copy of this form with next communication to Applicant.



FORM PTO-1449B

INFORMATION DISCLOSURE  
CITATION

Attorney Docket:

1232-5237

Serial No.:

10/735,062

Applicant:

A. KURIYAMA, et al.

Filing Date:

December 11, 2003

Group Art Unit:

2812

## NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.
	1.	RC. Furneaux, et al., The formation of controlled-porosity membranes from anodically oxidized aluminum; Nature, Vol. 333, p. 147, (1989)
	2.	Masuda, "Solid-state Physics", Vol. 31, p. 493, (1996)
	3.	X. Duan, et al., Indium Phosphide nanowires as building blocks for nanoscale electronic and optoelectronic devices; Nature, Vol. 409, p. 66, (2001)
	4.	M. Jacobs, et al., Unbalanced magnetron sputtered Si-A1 Coatings: plasma conditions and film properties versus sample bias voltage; Surface and Coatings Technology, 116-119 (1999) pp. 735-741
	5.	C. D. Adams, et al., Transition from lateral to transverse phase separation during film co-deposition; Appl. Phys. Lett., 59 (20), 11 November 1991, 2535-2537
	6.	M. Atzmon, et al; Phase separation during film growth; J. Appl. Phys. 72(2), 15 July 1992, 442-446
	7.	C. D. Adams, et al., Monte Carlo simulation of phase separation during thin-film codeposition; J. Appl. Phys. 74 (3), 1 August 1993, 1707-1715
	8.	C. D. Adams, et al; Phase separation during co-deposition of Al-Ge thin films; J. Mat Phys. Vol. 7, No. 3, p. 653-666 (1992)
	9.	
	10.	
	11.	
	12.	
	13.	
	14.	
	15.	
	16.	
	17.	

Examiner Signature	Date Considered
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 608. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. 1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached. This collection of information is required by 37 CFR 1.87 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

# **Exhibit C**

**MORGAN & FINNEGAN, LLP – DC OFFICE**

Serial No.	10/735,062	Docket No.	1232-5237
Applicant:	Akira KURIYAMA, et al.	Atty.:	EGW/crp
Filing Date:	December 11, 2003	Due Date:	February 4, 2005

The following was/ were received in the U.S. Patent and Trademark Office on the date stamped hereon:

- |  |   |
|--|---|
| <input type="checkbox"/> Amendment (or Response)             | <input checked="" type="checkbox"/> IDS, Form-1449& 16 references |
| <input type="checkbox"/> Petition for Mo. Ext. of Time       | <input type="checkbox"/> Related Case Submission, refs            |
| <input type="checkbox"/> Notice of Appeal                    | <input type="checkbox"/> Amendment Fee Transmittal                |
| <input type="checkbox"/> Response to Missing Parts           | <input checked="" type="checkbox"/> Appeal Brief                  |
| <input type="checkbox"/> Executed Declaration and POA        | <input type="checkbox"/> CPA Transmittal                          |
| <input type="checkbox"/> Assignment(s) & Cover Sheet         | <input type="checkbox"/> Check for \$                             |
| <input type="checkbox"/> Letter to the Official Draftsperson | <input checked="" type="checkbox"/> Deposit Account Authorization |
| <input type="checkbox"/> Sheets formal drawings              | <input type="checkbox"/> Other:                                   |



59605 v1